

Remarks

I. Introduction

With the withdrawal without prejudice of claims 4, 6 and 7, claims 1-3, 8 and 18 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Objection to Drawings

The drawings were objected to under 37 C.F.R. § 1.83(a) as failing to show every feature of the invention specified in the claims. As an initial matter, claims 4, 6 and 7 have been withdrawn without prejudice herein, therefore Applicant respectfully maintains that the objection with respect to these claims are moot.

While 37 C.F.R. § 1.83(a) requires that a drawing “show every feature of the invention specified in the claims,” it also provides that “conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention” should be — but are not required to be — “illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation.” The recited features of claim 1 are clearly disclosed in the accompanying figures, description and in the claims, and that further illustration of any such features beyond what is already illustrated in the accompanying figures is not essential and is not required for a proper understanding of the claims. For example, the feature of “the heating element being substantially flat when viewed in cross-section” is expressly described at page 5, lines 12-14 of the Specification and a person of skill in the art would not require an illustration beyond that already illustrated in the accompanying figures in order to have a proper understanding of the invention.

In view of the foregoing, it is respectfully submitted that the objections to the drawings have been obviated, and withdrawal of these objections is therefore respectfully requested.

III. Rejection of Claims 1-4, 6-8 and 18 Under 35 U.S.C. § 112, First Paragraph (Enablement)

Claims 1-4, 6-8 and 18 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. Applicant respectfully maintains that all of the claims are adequately enabled. However, for the purposes of expediting the prosecution of

this application, Applicant has withdrawn claims 4, 6 and 7 herein without prejudice. Therefore, Applicants respectfully request that this rejection be withdrawn with respect to these claims.

As to claim 1, the Examiner maintains that “the specification ... does not reasonably provide enablement for ‘the heating element having a heated surface that is flat across a width of the heated surface’ [and] does not enable a person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with [the] claims.” Applicant has amended claim 1 herein without prejudice to delete the language objected to by the Examiner, and to instead recite “the heating element being substantially flat when viewed in cross-section,” which is expressly described at page 5, lines 12-14 of the Specification, as admitted by the Examiner at page 3 of the Final Office Action.

Thus, Applicant respectfully maintains that the Specification and the claims are sufficiently enabling so as to enable any person skilled in the art to make and use the invention without undue experimentation.

**IV. Rejection of Claims 1-3, 6-7,
 13 and 18 Under 35 U.S.C. § 102(b)**

Claims 1-3, 6-7, 13 and 18 were rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 4,217,915 (“Gress”). Applicant respectfully submits that Gress does not anticipate the present claims for the following reasons. As an initial matter, claims 6 and 7 have been withdrawn without prejudice, and the rejection of this claim is moot.

Claim 1 relates to a hair straightening device. Claim 1 recites that the hair straightening device includes a handle, and a base portion having a proximal end adjacent to the handle, a distal end and a surface. Claim 1 also recites that the device includes a plurality of bristles extending from the surface of the base portion, each of the plurality of bristles having a tip. Also, claim 1 recites that the device includes a heating element extending between the proximal end and the distal end of the base portion. Claim 1 has been amended herein without prejudice to recite the heating element being substantially flat when viewed in cross-section. Support for this amendment can be found, for instance, at page 5, lines 12-14 of the Specification which states that “the hair straightening device 10 has a heating element 20 ... that is substantially flat when viewed in cross-section.” Claim 1 also recites that the heating element has a heated surface. Claim 1 also recites that the heating element is positioned between the surface of the base portion and the tips of the bristles.

It is respectfully submitted that Gress does not anticipate claim 1 for at least the reason that Gress does not disclose, or even suggest, all of the features recited in claim 1. For example, Gress does not disclose, or even suggest, a heating element being substantially flat when viewed in cross-section and that is positioned between the surface of the base portion and

the tips of the bristles, as recited in claim 1. The Specification states at page 9, lines 7-8 that “unlike with conventional hair straightening devices, the heat needed to relax the hair is not being used in conjunction with excessive force, pulling, or pressing.” The Specification also states at page 9, lines 9-10 that “[a]fter contacting the heating element, the hair is caused to be straightened and smoothed for a long-lasting style.”

Gress describes that “[t]he brush body 2 has a hollow outer cover or jacket 8, made of a material which is a good conductor of heat, for example metal [and] uniformly distributed over the circumference, in longitudinal as well as circumferential direction, are stubs or projections 10; in their simplest form, they are made of the same material as the cover 8 and are formed therewith as one single integral casting or molding, or are otherwise attached to the body 8.” Col. 2, lines 23-32. Gress also states that “[t]he stubs 10 are formed with radial bores which receive at least one bristle 1.” Col. 2, lines 32-34. Also, Gress states that “[t]he bristles 1 are made of a material which is a poor heat conductor, for example a plastic, or are natural bristles.” Col. 2, lines 34-36. Thus, **the only heated surface that is located between the surface of the body 8 and the tips of the bristles 1 are the stubs 10, which do not have a width and furthermore are not flat across any portion thereof**. The Examiner maintains that jacket 8 constitutes a flat heating element; however, the jacket 8 forms the surface of the base portion and therefore cannot constitute a heating element that is positioned **between** the surface of the base portion and the tips of the bristles. Even if the jacket 8 could be so considered (which it should not be), the jacket 8 is **curved**, not substantially flat, when viewed in cross-section, as shown in Figure 3 of Gress.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Gress does not anticipate claim 1, because Gress does not disclose, or even suggest, all of the features recited in the claim.

As for claims 2-3 and 18, each of which ultimately depends from and includes all of the limitations of claim 1, it is respectfully submitted that Gress does not anticipate these dependent claims for at least the same reasons given above in support of the patentability of claim 1.

V. Rejection of Claims 1-4, 7, and 18 Under 35 U.S.C. § 102(b)

Claims 1-4, 7 and 18 were rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,064,993 (“Hashimoto”). Applicants respectfully submit that Hashimoto does not anticipate the present claims for the following reasons. As an initial matter, claims 4 and 7 have been withdrawn without prejudice, and the rejection of these claims are moot.

It is respectfully submitted that Hashimoto does not anticipate claim 1 for at least the reason that Hashimoto does not disclose, or even suggest, all of the features recited in claim 1. For example, Hashimoto does not disclose, or even suggest, a heating element being substantially flat when viewed in cross-section and that is positioned between the surface of the base portion and the tips of the bristles, as recited in claim 1.

Hashimoto describes that “between the comb tooth plates 1a and 1b an electrical heating wire 3 is provided which extends in the longitudinal direction of the hair treatment implement in the vicinity of the base portions of the comb teeth.” Col. 3, lines 9-11. Hashimoto further states that “[t]he comb tooth portion 1 and the hand grip 2 are made of a heat-resisting resin material, similar to the heater cassette 30.” Col. 4, lines 14-16. **The only heating element is the heating wire 3, which is not located between the surface of a base and the tips of bristles.** Furthermore, the heating wire 3 is repeatedly described as being “string”-like in shape, and therefore **the heating wire 3 is round when viewed in cross-section, not flat** as required by the claim.

Therefore, it is respectfully submitted that Hashimoto does not anticipate claim 1, because Hashimoto does not disclose, or even suggest, all of the features recited in the claim. As for claims 2, 3 and 18, each of which ultimately depends from and includes all of the limitations of claim 1, it is respectfully submitted that Hashimoto does not anticipate these dependent claims for at least the same reasons given above in support of the patentability of claim 1.

VI. Rejection of Claim 8 Under 35 U.S.C. § 103(a)

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gress or Hashimoto in view of U.S. Patent No. 6,053,180 (“Kwan”). It is respectfully submitted that the combination of Gress or Hashimoto and Kwan does not render obvious the present claims herein for the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28

U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Applicants respectfully submit that the combination of Gress or Hashimoto and Kwan does not render obvious claim 1, from which claim 8 depends, for at least the reasons that the combination of Gress or Hashimoto and Kwan fails to disclose, or even suggest, all of the limitations recited in claim 1, from which claim 8 depends. As stated above, neither Gress nor Hashimoto disclose, or even suggest, a heating element being substantially flat when viewed in cross-section and that is positioned between the surface of the base portion and the tips of the bristles, as recited in claim 1. Furthermore, Kwan is not relied upon to disclose or suggest, and in fact does not disclose or suggest, those features of claim 1 that are not disclosed or suggested by Gress or Hashimoto. **As shown in Figure 1c of Kwan, there is no heated surface between a base portion and the tips of the bristles 4.**

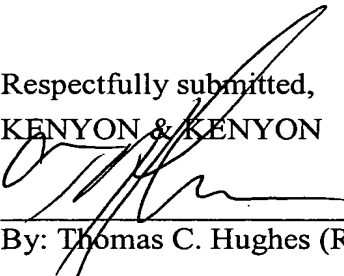
Thus, it is respectfully submitted that the combination of Gress or Hashimoto and Kwan does not render obvious claim 8, which depends from claim 1. In re Fine, supra (any claim that depends from a non-obvious independent claim is non-obvious).

VII. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Dated: May 23, 2006

Respectfully submitted,
KENYON & KENYON

By:  (Reg. No. 42,674)

One Broadway
New York, NY 10004
Tel: (212) 425-7200; Fax: (212) 425-5288